

MAR 28 2007

Serial No.: 09/911,143

Examiner: Jorge L. Ortiz-Crudo

Title: OPTICAL ELEMENT, OPTICAL HEAD, OPTICAL RECORDING/REPRODUCING APPARATUS AND OPTICAL
RECORDING/REPRODUCING METHOD

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REMARKS

Reconsideration is requested in view of the following remarks. Claim 34 remains pending in the application.

Claim Rejections – 35 USC § 112

Claim 34 is rejected under 35 USC § 112, first paragraph, for failure to comply with the written description requirement. The rejection contends that the claim language “said administrative information of the optical recording medium including at least one of a recording and reproduction condition of the optical recording medium” is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention. Applicants respectfully submit that the present specification provides sufficient support for the claim language.

The rejection contends that the Declaration of Mr. Matsuzaki filed with the last Response merely provides speculation and conclusions without providing sufficient factual statements. Applicants respectfully disagree and contend that the Declaration in fact is more than sufficient to demonstrate presents sufficient facts to show that the “administrative information of the optical recording medium including at least one of a recording and reproduction condition of the optical recording medium” at least is disclosed implicitly if not inherently in the specification.

The statements made under oath in the Declaration must be accepted by the PTO absent compelling reasons to the contrary. As stated in In re Marzocchi, 169 USPQ 367, 370, 439 F.2d 220, 224 (CCPA 1971), “In any event, it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.” See also In re Fisher, 169 USPQ 602, 605, 441 F.2d 664, 668 (CCPA 1971).

Mr. Matsuzaki asserts at page 2 of the Declaration that one of ordinary skill would have understood the present specification to support the requirement “said administrative information of the optical recording medium including at least one of a recording and reproduction condition of the optical recording medium”. Mr. Matsuzaki

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next provides several pages of explanation for the factual basis underlying this conclusion. This includes detailed analysis of specific aspects of the present disclosure, with accompanying comments as to how these aspects of the disclosure would have been understood.

The Office Action raises no issues concerning the qualifications of Mr. Matsuzaki set forth in the Declaration, and Applicants submit that Mr. Matsuzaki, who is not one of the named inventors of the present application, clearly is well-qualified to explain the factual issue of how different parts of the present specification would be understood by those skilled in the art. The Office Action provides no countering evidence or even an unsupported disagreement with any of the factual points raised by Mr. Matsuzaki in his opinion. As such, Applicants respectfully submit that the Mr. Matsuzaki's explanation of the factual issue of how the present specification would be understood by one skilled in the art must be accepted and the rejection should be withdrawn.

Claim Rejections – 35 USC § 102

Claim 34 is rejected under 35 USC § 102(b) as being anticipated by Kashiwagi (US 6,175,548). Applicants respectfully traverse this rejection.

Claim 34 requires a first recording layer of an optical recording medium having recorded thereon administrative information of the optical recording medium including at least one of a recording and reproduction condition of the optical recording medium, and a distance from a surface of the optical recording medium on which the laser beam is incident to the first recording layer being $100\mu\text{m} \pm 10\mu\text{m}$. By providing the administrative information including at least one of a recording and reproduction condition of the optical recording medium on the first recording layer located $100\mu\text{m} \pm 10\mu\text{m}$ from the laser beam incident surface of the multi-layer optical recording medium, the administrative information of the optical recording medium can be reproduced without requiring a determination of whether the optical recording medium set in a recording/reproduction apparatus is a single layer optical recording medium or a multi-layer recording medium (see Fig. 12A and page 27, line 30 to page 30, line 11 of the present specification).

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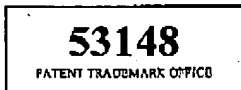
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Kashiwagi fails to disclose a first recording layer of an optical recording medium having recorded thereon administrative information of the optical recording medium including at least one of a recording and reproduction condition of the optical recording medium, as recited by claim 34. In fact, Kashiwagi is completely silent as to the administrative information required by claim 34. For at least these reasons, claim 34 is patentable over Kashiwagi.

In view of the above, favorable reconsideration in the form of a notice of allowance is respectfully requested. Any questions regarding this communication can be directed to the undersigned attorney, Douglas P. Mueller, Reg. No. 30,300, at (612) 455-3804.



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DPM/cy

Respectfully submitted,

HAMRE, SCHUMANN, MUELLER &
LARSON, P.C.
P.O. Box 2902-0902
Minneapolis, MN 55402-0902
(612) 455-3800

By: 

Douglas P. Mueller
Reg. No. 30,300